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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jorn Karl

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

12/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,704	<b>Applicant(s)</b> KARL ET AL.	
	<b>Examiner</b> JAMES W. ROGERS	<b>Art Unit</b> 1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,14,15,21,23-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) 6-11,14,15,21 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,23,28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants amendments to the claims filed 09/18/2009 have been entered. Any rejection/objection from the previous office action filed 06/18/2009 not addressed in the action below has been withdrawn.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5,22-23 and 28 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Slaney et al. (WO 03/040078, US 6,906,222 B2 used as English equivalent, cited previously).

Slaney teaches methods of preparing formic acid formates including preferably trisodium tetraformate, the acid formates were said to be useful in preserving or acidifying materials of plant or animal origin and for animal nutrition as growth promoters. See abstract, col 1 lin 6-9, lin 66-col 2 lin 35, col 6 lin 29-col 7 lin 17. Regarding the limitation within the preamble that the preparation is a coating, the

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examiner considers the limitations met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I, ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81. Slaney further teaches that it is advantageous to compress the acid formats with a desiccant including starches. See col 6 lin 59-64.

Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Hjernevik (US 6,137,005, cited previously).

Hjernevik teaches formate based products containing salts of formic acid including a mixture of diformate/trisodium tetraformate. See abstract and examples. The formate based product could be used as an animal feed. As stated above the limitation within the preamble that the preparation is a coating, the examiner considers that limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I. A desiccant such as starch could be added to the formats to further dehydrate the formats. See col 2 lin 18-20.

Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Hjernevik (EP 1,273,238 A2, cited previously).

Hjernevik teaches the use of animal feed additives that are useful in promoting growth including diformate salts such as trisodium tetraformate. See [0003],[0008]-[0009],[0014]-[0015],table 1a. As stated above the limitation within the preamble that the

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preparation is a coating, the examiner considers the limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I. A desiccant such as starch could be added to the formats to further dehydrate the formats. See [0014].

Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnsen et al. (6,132,796).

Johnsen teaches a method of producing feed for salmonides, the feed incorporated trisodium tetraformate. See abstract and examples including table 1 and 2. As stated above the limitation within the preamble that the preparation is a coating, the examiner considers the limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I. The feed included numerous ingredients such as fish meal, grounded wheat, digestible starch, pigments, minerals and vitamins.

Claims 1,3,23 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjernevik et al. (WO 01/19207 A1).

Hjernevik teaches an aqueous preservative/acidifier for grass and other agricultural crops as well as meat and fish products comprising a combination of formic acid and formate salts that includes ammonium tetraformate (reads on claimed component A), the composition could further contain benzoic acid (component B). See abstract and claims. Regarding applicants intended use recitation "coated preparation" in the preamble of the claim, since the formulation of Hjernevik is aqueous it will be capable of coating a substrate such as a crop or meat product, or at least the aqueous

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solution is capable of coating a substrate. The term "coated" is not seen as being very limiting by the examiner and could just mean a composition that is applied to some type of a substrate or object.

Claims 1,3,23 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoyvik et al. (US 2005/0070438 A1).

Hoyvik teaches impregnating agents for wood against fungi, the agent comprises a mixture of potassium diformate and/or acetic acid and/or benzoic acid and/or a fixating agent that includes other formates such as ammonium tetraformate. See abstract, [0010] and claims. As stated above the limitation within the preamble that the preparation is a coating, the examiner considers the limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate and component B which includes benzoic acid.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3,23 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krochta et al. (US 5,019,403) in view of Slaney et al. (WO 03/040078, US 6,906,222 B2 used as English equivalent).

Krochta discloses a preservative coating for substrates such as food or plant materials that contains a hydrophobic material in which beeswax, carnauba wax, hydrogenated soybean oil or cottonseed oil could be selected. See abstract, col 3 lin 9-18 and claims. The coatings of Krochta were said to extend the shelf life of food

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products or plant materials by providing a barrier to moisture, oxidative damage and microbial attack. See col 2 lin 59-65 and col 3 lin 9-19. Krochta does not describe the use of a tetraformate as claimed by applicants.

Slaney is described in the previous office action filed 06/18/2009 and above.

Slaney is used primarily for the disclosure within that the use of acid formates such as tetraformate, particularly trisodium tetraformate, were well known to be useful as preserving agents in agricultural crops, fish and meat products with well established anti-microbial activity. See col 1 lin 6-10, col 6 lin 65-col 7 lin 4. Since the two references are generally related to the same field of endeavor, preservatives for food or plant materials one of ordinary skill in the art would have a high expectation of success in adding the acid formates of Slaney into the preservative coating of Krochta. The reason to make such a modification to Krochta would be to provide an additional anti-microbial effect to the coating by incorporating the acid formates of Slaney. It therefore follows that the instant claims define prime facie obvious subject matter.

Claims 1-3,5,23,28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krochta et al. (US 5,019,403) in view of Slaney et al. (WO 03/040078, US 6,906,222 B2 used as English equivalent) in view of Foxcroft et al. (EP 0,009,366, cited previously).

Krochta and Slaney are disclosed above, including the reasoning for why their combination would be obvious. The combination of Krochta and Slaney do not describe powdered preparations as required in dependent claims 5 and 28.

Foxcroft is described in the previous office action filed 06/18/2009. Foxcroft discloses milk containing animal feed containing sprayed on stabilizers (preservatives) such as ammonium tetraformate. Foxcroft is used primarily for the disclosure within that preservative coatings were well known to be used in powdered food formulations. Since the references are generally related to the same field of endeavor, preservatives for food or plant materials one of ordinary skill in the art would have a high expectation of success in coating the powders of Foxcroft with the preservative composition made by the combination of Krochta and Slaney. The reason to coat powders with a preservative coating containing tetraformates would be to provide a barrier to moisture, oxidation and microbes to the food product, advantageously extending the shelf life of that product. It therefore follows that the instant claims define prime facie obvious subject matter.

Claims 1-3,23 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hjernevik et al. (WO 01/19207 A1) in view of Slaney et al. (WO 03/040078, US 6,906,222 B2 used as English equivalent) in view of Krochta et al. (US 5,019,403).

Hjernevik is disclosed above. Hjernevik does not describe the use of the specific tetraformate trisodium hydroformate as required in claim 3, nor does Hjernevik disclose the use of the oils in claim 30 or the celluloses, waxes and polymers in claim 32.

Slaney is described above. Slaney is used primarily for the disclosure within that the use of trisodium tetraformate was well known to be useful as a preserving agents in agricultural crops, fish and meat products.



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Krochta discloses a preservative coating for substrates such as food or plant materials that contains a hydrophobic material in which beeswax, carnauba wax, hydrogenated soybean oil and cottonseed oil could be selected. See abstract, col 3 lin 9-18 and claims. The coatings of Krochta were said to extend the shelf life of food products or plant materials by providing a barrier to moisture, oxidative damage and microbial attack. See col 2 lin 59-65 and col 3 lin 9-19. Since all of the references are generally related to the same field of endeavor, preservatives for food or plant materials one of ordinary skill in the art would have a high expectation of success in combining the references described above. One of ordinary skill in the art would have a high expectation of success in adding and/or substituting sodium tetraformate within Slaney for the ammonium tetraformate of Hjernevik. It is generally considered to be prime facie obvious to combine and/or substitute compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. One of ordinary skill in the art would also have a high expectation of success in adding the hydrophobic materials of Krochta to the composition of Hjernevik. The reason to make such a modification to Hjernevik by incorporating the coating materials of Krochta would be to provide a barrier to moisture, oxidation and microbes to the food product, advantageously extending the shelf life of the food product. It therefore follows that the instant claims define prime facie obvious subject matter.

Claims 1,3,5,23,28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hjernevik et al. (WO 01/19207 A1) in view of Foxcroft et al. (EP 0,009,366).

Hjernevik is disclosed above. Hjernevik while describing the use of the inventive composition as a preservative/acidifier for food products in general it does not describe using the composition for preserving powdered food products as required in claims 5 and 28.

Foxcroft is disclosed above and is used primarily for the disclosure within that preservative coatings were well known to be used in powdered food formulations. Since the references are generally related to the same field of endeavor, preservatives for food or plant materials one of ordinary skill in the art would have a high expectation of success in coating the powders of Foxcroft with the preservative composition of Hjernevik. The reason to coat powders with the preservative/acidifying composition of Hjernevik would be to extend the shelf life of the powdered food product.

### ***Conclusion***

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618